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UNITED STATES DISTRICT COURT

NORTHERN DISTRICT OF CALIFORNIA – SAN JOSE DIVISION

In re

ACACIA MEDIA TECHNOLOGIES CORPORATION

Case No. C-05-01114 JW

ROUND 1 AND 2 DEFENDANTS' CLAIM CONSTRUCTION BRIEF ('992 AND '275 PATENTS)

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Judge: Honorable James Ware

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The Round 1 and 2 Defendants[1] submit the following claim-construction brief with respect to the ‘992 and ‘275 patents.

I. INTRODUCTION

Nobody understands the Yurt family of patents, including their owner, Acacia. Acacia's 108-page effort to make sense of the incoherent and self-contradictory claims in the ‘992 and ‘275 patents makes that fact abundantly clear. Indeed, Acacia appears to have taken its lead from the patentees, and contradicts both the patents and itself in its failed attempt to avoid the conclusion that the patents are indefinite.

For example, Acacia concedes, as it must, that the term "reception system" cannot mean the same thing as "receiving system," but faced with the patents' contradictory use of the latter term, Acacia simply throws up its hands and asserts, with no support whatsoever, that these terms *switch meanings* between the ‘992 and ‘275 patents. According to Acacia, in the ‘992 patent, the "receiving system" has the meaning this Court ascribed to "reception system," but with the addition of playback functionality. In the ‘275 patent, on the other hand, Acacia gives "receiving system" exactly the same construction that this Court gave "reception system," and argues that it is the "reception system" that must change its meaning and perform the added playback functions. Acacia's argument, like the term "receiving system" itself, simply makes no sense.

Acacia also concedes that, as claim 47 of the ‘992 patent states, the "memory means" is "in the receiving system." And it concedes that an "intermediate storage device" must be located

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[1] The following defendants join this brief: Comcast Cable Communications LLC; Insight Communications, Inc.; Cable One, Inc.; Mediacom Communications Corporation; Bresnan Communications; Cequel III Communications I, LLC (dba Cebridge Connections); Charter Communications, Inc.; Armstrong Group; Block Communications, Inc.; East Cleveland Cable TV and Communications LLC; Wide Open West Ohio LLC; Massillon Cable TV, Inc.; Mid-Continent Media, Inc.; US Cable Holdings LP; Savage Communications, Inc.; Sjoberg's Cablevision, Inc.; Loretel Cablevision; Arvig Communications Systems; Cannon Valley Communications, Inc.; NPG Cable, Inc.; Coxcom, Inc.; Hospitality Network, Inc.; Ademia Multimedia LLC; ACMP, LLC; AEBN, Inc.; Audio Communications, Inc.; Club Jenna, Inc.; Cyber Trend, Inc.; Cybernet Ventures, Inc.; Game Link, Inc.; Global AVS, Inc.; Innovative Ideas International; Lightspeed Media Group, Inc.; National A-1 Advertising, Inc.; New Destiny Internet Group LLC; and VS Media, Inc. Each defendant joins only with respect to the construction of terms within claims that Acacia is currently asserting against that defendant.

"between the transmission system and the receiving system." But claim 53 states that "the memory means *is* an intermediate storage device." So Acacia is forced to claim that the memory means must be simultaneously inside and outside of the "receiving system." That makes no sense either.

Acacia also argues that the step of storing information in claim 23, which must occur at the "head end of a cable television reception system," is both "part of" and "performed before" the step of storing in claim 19 to which it refers, which must occur at the user's "selected location"—*i.e.*, where the user is going to watch the program he or she requests. This contradictory assertion is an attempt to avoid the plain, albeit bizarre, meaning of the claim, which requires that information be stored at a "reception system" at the head end *after* it is received by a "receiving system" at the user's home.

Aside from these incoherent arguments with respect to the "receiving system," Acacia makes a number of other unsupportable arguments regarding the meaning of the terms in the Yurt patents, which are discussed in further detail below. For example, Acacia contradicts the patentees' repeated statements about the meaning of "selected," as well as the ordinary meaning of that term, in an effort to argue that a user "selects a location" simply by pressing "play" to watch a movie. But pressing "play" has nothing to do with "selecting a location." A user must press "play" *any time* he or she watches a movie. Thus, Acacia's construction robs the limitation of any effect whatsoever—which, of course, is Acacia's goal.

For the foregoing reasons, and others set forth more fully below, the Court should adopt the constructions proposed by the Round 1 and 2 Defendants and hold that '992 claims 19-40 and 47-58, and '275 claims 2 and 5, are invalid for indefiniteness.

II. ARGUMENT

1. "Distribution method responsive to requests from a user identifying items in a transmission system containing information" ('992 patent, claim 19)

That the preamble of claim 19 is limiting is addressed in the brief filed by the Round 3 Defendants. Should the Court conclude that the preamble is limiting, the parties appear to agree that it requires at least that: (1) a user identify items, (2) the items be contained in the transmission system, and (3) the items contain information.

2. "Remote locations" ('992 patent, claims 19, 41, 47; '275 patent, claims 2, 5)

The term "remote locations" is addressed below in No. 8 (remote location selected by the user). It does not need to be construed separately.

3. "Storing, in the transmission system, information from items in a compressed data form, the information including an identification code and being placed into ordered data blocks" ('992 patent, claims 19, 47; '275 patent, claims 2, 5)

Round 1 and 2 Defendants ask the Court to construe this claim element exactly as it reads. Because the patentee is required to "define precisely what his invention is," it is "unjust to the public, as well as an evasion of the law, to construe it in a manner different from the plain import of its terms." *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005) (en banc) (quoting *White v. Dunbar*, 119 U.S. 47, 52 (1886)).

The claim element at issue here recites the step of storing information from items "in a compressed data form." The claim further describes "the information" as "including an identification code and being placed into ordered data blocks." Because the identification code is "includ[ed]" in "the information" that is stored in a "compressed data form," the identification code must be compressed. Likewise, because the information that is stored in a compressed data form must be placed into ordered data blocks, the ordered data blocks must also be compressed. This construction follows directly from the claim language.

Acacia is trying to rewrite the phrase to be "storing, as a file, the compressed, formatted, and sequenced data blocks *with* the assigned unique identification code." '992 Claim 41 (emphasis added); Acacia Br. at 10-11. In doing so, Acacia simply ignores the claim language—in particular, the word "including." Instead, Acacia argues that "the identification code is not 'information from items,' it is a code that, as described in the specification, is assigned to the information for identifying the information." Acacia Br. at 10. But the specification cannot be used as a justification for Acacia's efforts to rewrite '992 claims 19 and 47 and '275 claims 2 and 5 as if they contained the word "with," rather than "including." The Federal Circuit "repeatedly and consistently has recognized that courts may not redraft claims, whether to make them operable or to sustain their validity. . . . Thus, in accord with our settled practice we construe the claim as written, not as the patentees wish they had written it." *Chef Am., Inc. v. Lamb-Weston, Inc.*, 358 F.3d 1371, 1374 (Fed. Cir. 2004) (construing claim to require that dough, rather than oven, be heated to 400°–850°, with result that dough would be incinerated).[2]

Accordingly, the Court should construe the phrase at issue here in accordance with its plain meaning, which requires that both the identification code and the ordered data blocks must be stored in a compressed data form.

4. "Receiving system" ('992 patent, claims 19, 47; '275 patent, claims 2, 5)

The term "receiving system" is used 72 times in the '992 patent and 45 times in the '275 patent. But the sheer number of times the term is used has not bred clarity as to its meaning or scope. To the contrary, the Yurt patents use the term "receiving system" in such contradictory, confusing and inconsistent ways as to render it "not amenable to construction" and "insolubly ambiguous," thereby rendering the claims in which it appears invalid under 35 U.S.C. § 112, ¶ 2. *See Datamize, LLC v. Plumtree Software, Inc.*, 417 F.3d 1342, 1347 (Fed. Cir. 2005).

Fundamental canons of claim construction dictate that, in the Yurt patents, "receiving system" means something different than "reception system."[3] The patents use the two terms distinctly, even within the same claim. For instance, claims 2 and 5 of the '275 patent each contain the following element:

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[2] Claim 19 also provides that the information must be placed into ordered data blocks. Acacia appears to take the curious position that this requirement is not a limitation of the claim. Acacia argues that "placed into ordered data blocks" is in the past tense, and therefore the act of placing the information into ordered data blocks need not occur in order for the Court to find infringement of Claim 19. Acacia is wrong both as a matter of grammar and as a matter of logic. Claim 19 recites that information "being placed into ordered data blocks" is then stored. "Being" is in the present tense, not the past tense. Moreover, claim 19 uses a verb ("being placed") to describe an action associated with creating the ordered data blocks. If placing the information into ordered data blocks were not a claim limitation, there would be no reason to have the verb—instead the claim would simply require that the information *be* in ordered data blocks, not *be placed* into ordered data blocks.

[3] In its July 12, 2004 Markman Order ("*Markman I*"), the Court construed "reception system" to mean "an assembly of elements, hardware and software, capable of functioning together to receive items of information." *Markman I* at 28. No party sought reconsideration of that ruling in the second round of claim construction.

> sending a request, by the user to the transmission system, for at least a part of the stored information to be transmitted to **a reception system associated with a receiving system** at one of the remote locations selected by the user;

'275 Claims 2 & 5 (emphasis added). Likewise, in the '992 patent, dependent claims 23 and 49 recite a "reception system" that is different from the "receiving system" in the claims from which they depend. *See* '992 Claims 19, 23, 47 & 49.

The patentees' use of two different terms—within a single claim, a single claim element, and even a single phrase such as "*a reception system* associated with *a receiving system*"—demonstrates that each term has a different meaning. *See Bancorp Servs., L.L.C. v. Hartford Life Ins. Co.*, 359 F.3d 1367, 1373 (Fed. Cir. 2004) ("[T]he use of both terms in close proximity in the same claim gives rise to an inference that a different meaning should be assigned to each."); *Innova/Pure Water, Inc. v. Safari Water Filtration Sys.*, 381 F.3d 1111, 1119 (Fed. Cir. 2004) ("[W]hen an applicant uses different terms in a claim it is permissible to infer that he intended his choice of different terms to reflect a differentiation in the meaning of those terms."). Acacia agrees. It has assigned the terms "receiving system" and "reception system" different definitions—although, as discussed below, Acacia's attempt to find a meaning for "receiving system" violates logic and the most basic principles of claim construction.

To determine what a "receiving system" might be, the Court must first consult the claim language. *See Phillips*, 415 F.3d at 1312. The claims, however, render "receiving system" not merely vague, but logically incoherent. For example, claim 19 of the '992 patent provides that the receiving system is at "the remote location selected by the user." '992:22:37-40. The claim then requires, among other steps, sending information that the user has requested; "receiving the sent information *by the receiving system at the selected remote location*;" and then "storing a complete copy of the received information *in the receiving system at the selected remote location* . . . ." '992:22:40-47. Thus, at first blush, the "receiving system" appears to be some kind of system at the location the user has selected to which information can be sent.

But one need only read a few lines further to find the patentees contradict themselves. Claim 23, which depends from claim 19, requires that the step of storing—which must occur "*in* the receiving system *at* the selected remote location"—also "includes the step of storing the received information *at the head end of a cable television reception system.*" '992:23:5-8 (emphasis added). Thus, according to claim 23, the "receiving system" *cannot* be a system at the location the user has selected, but rather is something larger, the boundaries of which are unknown, but which encompasses, at a minimum, the ability to store information at the head end of a cable television reception system.[4]

Recognizing that this contradiction makes the term "receiving system" incomprehensible, Acacia has argued that claim 23 must be interpreted differently. According to Acacia, even though claim 23 requires that claim 19's step of storing—which occurs *in* the receiving system, *at* the selected remote location—must "include" storing at a head end, in fact these are two discrete steps. Acacia Br. at 41:7-10. Further, Acacia argues, it is "well-known to persons of skill in the art" that each of these steps occurs at different times, and that the information "is stored at the head end of the cable system *before* it is received at the receiving system." *Id.* at 42:11-15 and 43:13-16 (emphasis added). Thus, according to Acacia, claim 23 actually describes a method of storing information at a cable head end before that information ever reaches a "receiving system" at the user's selected location.

That wishful explanation, however, flatly contradicts what the claim says. Acacia concedes, as it must, that the steps of claim 19 must be performed in order, and that the "storing" step (the one that claim 23 modifies) must occur *after* the step that precedes it—namely, "*receiving* the sent information *by the receiving system at the selected remote location.*"[5] Consistent with this required sequence, claim 23 describes storing at the head end not just any information, but specifically "the *received* information"—that is, the information that was already received by the "receiving system" in the preceding step. '992:23:5-8 (emphasis added).

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[4] "Head end" is a commonly used cable television term which the parties have not asked the Court to construe. Generally speaking, it is the control center of a cable television system, where incoming signals are amplified and processed for transmission to subscribers. *See, e.g.*, http://en.wikipedia.org/wiki/Headend; *see also* Acacia Br. at 41 n.9 (describing "head end" as "the facility at a local cable TV office that originates and communicates cable TV services to subscribers.").

[5] Claim 19 recites two separate steps of storing, but Acacia and all the defendants agree that claim 23 refers to the second storing step.

There is simply no escaping the fact that claim 23 requires storing information at a head end *after* that information has been received by a "receiving system" at the user's selected location—not before. Thus, the Yurt patents require that a "receiving system" be both at the user's selected location for receiving information, and also somehow possess, at a minimum, the ability to store the same information later at the head end of a cable television reception system.

As Acacia tried to do with the term "sequence encoder," it may urge the Court to brush aside this paradox as yet another instance of "sloppy" drafting in the Yurt patents, *see* Tr. of Sept. 9, 2005 Hrg. at 398:14-17, and argue that the term "receiving system" still somehow retains a discernable and definite meaning, even if that meaning is inconsistent with the usage of "receiving system" in certain dependent claims. But the Federal Circuit recently rejected a similar argument in *Wilson Sporting Goods Co. v. Hillerich & Bradsby Co.*, 2006 U.S. App. LEXIS 7169 (Fed. Cir. March 23, 2006). There, the district court had construed the term "gap" to require "a single continuous space or void." But some claims attached various modifiers to "gap," including "annular" and partially annular ("at least part of an annular shape"). ("Annular" means "of or relating to an area formed by two concentric circular or curved regions.") The court concluded that a "gap" as used in *all* the claims thus must be capable of being either "annular" or only partially annular: "giving 'annular' its proper place in the construction of the claims informs the interpretation of 'gap.'" *Id.* at *14-15. Similarly, the features of a receiving system as set forth in the dependent claims must inform the interpretation of receiving system. In other words, the definition of a receiving system cannot exclude the receiving systems that are described in the dependent claims.

Here, however, it is impossible to identify the boundaries of the receiving system described in the claims of the '992 patent. Examples abound. Claim 47 is an apparatus claim which, again, recites a "receiving system" that is "at one of the remote locations selected by the user." '992:25:47-48. Included in this "receiving system" is a "memory means." '992:25:54-55. Dependent claim 53 then recites that this "memory means" is an "intermediate storage device." '992:26:24-26. But by Acacia's own admission, that is simply impossible. Acacia itself defines "intermediate storage device" as "a storage device (a device that stores) which is *between* the transmission system and the receiving system." Acacia Br. at 44:7-9 and 91:16-18 (emphasis added).[6] In other words, what makes such a device "intermediate" is that it is in neither the transmission system nor the "receiving system" (whatever that might be), but instead lies somewhere in between. But the claims require the "receiving system" to *encompass* intermediate storage devices, by dictating that such devices are an embodiment of the memory means of claim 47, which must be "*in* the receiving system." '992:25:54-55 and 26:24-26 (emphasis added). Once again, therefore, the Yurt patents describe "receiving system" in paradoxical terms—as including something that, by definition, lies outside of it. *Id.; see also* '992 Claim 24 (requiring that claim 19's step of storing received information "in the receiving system" include "storing the received information in an intermediate storage device").

As still another example, dependent claims 49 through 52 require that the same memory means of claim 47—which, again, must be *in* the "receiving system," *at* the user's selected location—include a "means for receiving information at the head end of a cable television reception system." '992:26:7-10. Thus, the patents dictate that a "receiving system" must be at the user's selected location, but must still somehow be capable of receiving information far away from that location, at the head end of a cable television reception system. As a result of their repeated inconsistencies and logical impossibilities, the Yurt claims provide persons skilled in the art with no understanding of what a "receiving system" is, or possibly could be.

The claims, of course, "must be read in view of the specification, of which they are a part." *Phillips*, 415 F.3d at 1315 (quoting *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 979 (Fed. Cir. 1995)). But the Yurt patents' specification likewise uses the term "receiving system" in inconsistent ways. At times, the specification suggests that a "receiving system" may be a collection of "reception systems." *See, e.g.*, '992:3:61-68 ("the transmission and *receiving system* of the present invention may alternatively comprise a *plurality of reception systems* 200, 200', 200", and 200"', which are each associated with a single transmission system 100.") (emphasis added). Figure 3 similarly illustrates multiple reception systems (groups of which are

[6] The Round 1 and 2 Defendants agree with this construction.

outlined by dashed lines that appear to indicate receiving systems). But elsewhere, the specification suggests that multiple reception systems are *connected* to the receiving system, making plain that one cannot comprise the other. *See, e.g.*, ‘992:10:42-45 (“Access to any of the files stored in compressed data library 118 is available from *multiple reception systems* 200 connected to the transmission and *receiving system*.” (emphasis added).

And that’s not all. Figure 1g illustrates, and the specification describes, a *reception* system that is transmitting over airwave channels to multiple users. ‘992:4:52-57 (“FIG 1g shows a . . . transmission system 100 distributing to a reception system 200, which then preferably transmits requested material over airwave communication channels 200d, to a plurality of users”). But the specification then refers to the “airwave transmission and *receiving* system shown in Fig 1g,” suggesting that the reception system (which is doing the airwave transmission) is transmitting over the airwaves to a receiving system, the nature of which is completely undefined. ‘992:4:61-63. Moreover, while the specification here describes structure 200 as a “reception system,” elsewhere it also describes that same structure as “*receiving system* 200,” further obscuring what the difference between the two kinds of systems might be. ’992:8:36-42; *see also* ‘992:3:39-40 and 17:67-18:1 (alternately describing Figure 6 as both “the *receiving system* of the present invention” and “the *reception system* 200 according to the present invention.”).

Whereas the preceding passages suggested that, in some cases, the reception system might transmit information to the receiving system, the specification elsewhere suggests the opposite, by stating that “received information” (presumably information that is received by the receiving system) is preferably buffered and “then played back to the reception system of the user.” ‘992:l9:30-36. And, to cap it all off, the specification provides that the communications controller makes a connection to “the reception system of the user” by “dialing the receiving device of the user” at which time the “reception system 200 preferably answers the call and confirms the connection,” making it impossible to tell how the receiving system and the reception system are distinct. ‘992:16:38-44.

Faced with these conflicting and incomprehensible disclosures, Acacia has proffered several different constructions of "receiving system," which only demonstrate that Acacia, too, is confused about the definition of the "receiving system" of the Yurt patents. First, Acacia proposed that "[t]he receiving system is a system for receiving transmitted information and for playing back the received information," and that the term has this same meaning in both the '992 and '275 patents. *See* Declaration of David J. Silbert ("Silbert Decl.) Ex. A (Acacia's proposed constructions sent March 17, 2006) at 2, 12. A few weeks later, however, Acacia proffered new constructions of "receiving system," this time asserting that the term has *different* meanings in the '992 and '275 patents. In the '992 patent, Acacia proposed that:

> [t]he receiving system is an assembly of elements, hardware and software, capable of functioning together to receive information[,] store information, and be used to play back information. To "play back" information means to send signals to a system, such as an audio amplifier and/or television, on which information can be displayed and/or heard.

Acacia Br. at 13:21-24. In the '275 patent, Acacia proposed that the definition of "receiving system" does not encompass the capability of storing and playing back information—but that these capabilities are *included* in the definition of "reception system" in the '275 patent. *Id.* at 93:19-25.

Not only do Acacia's various definitions fail to resolve the logical conundrums that the Yurt patents impose on the term "receiving system," they create additional ones. First, Acacia argues that the terms "receiving system" and "reception system" each mean something different in the '992 patent than they do in the '275 patent—or more precisely, that they *switch* meanings in the two patents, so that a "receiving system" of the '992 patent is the same as a "reception system" of the '275 patent, and vice versa. But, besides being bizarre, such a role reversal would violate the canon of claim construction, which Acacia itself relies on, that a claim term has the same meaning across a patent or patent family. *See* Acacia Br. at 19:15-23 (citing *Wilson*, 2006 U.S. App. LEXIS 7169, at *13). As the Federal Circuit recently reaffirmed in *Wilson*, "[u]nder this court's case law, the same terms appearing in different claims in the same patent . . . should have the same meaning unless it is clear from the specification and prosecution history that the terms have different meanings at different portions of the claims." *Wilson*, 2006 U.S. App. LEXIS 7169 at *13 (quoting *Fin. Control Sys. Pty, Ltd. v. OAM, Inc.*, 265 F.3d 1311, 1318 (Fed.

Cir. 2001)). The specification and prosecution history of the Yurt patents say no such thing. Instead, Acacia has simply switched its definitions of two terms in violation of the rules of claim construction to try to salvage some meaning for the term “receiving system.”

More fundamentally, Acacia’s changing constructions do not even acknowledge the patents’ numerous conflicting disclosures about the “receiving system” that make that term impossible for a person skilled in the art—or anyone else—to comprehend. While Acacia agrees that the “receiving system” is different from the “reception system,” it cites no explanation in the specification of what the difference is supposed to be. (Indeed, ironically, much of Acacia’s discussion of the term “receiving system” relies on passages in the specification that actually describe the “reception system.” *See* Acacia Br. at 14:21-15:19 and n.7.) Nor does Acacia explain how a “receiving system” may be at the location that a user has selected to send information to, yet still somehow be capable of both *receiving* information at the head end of a cable television reception system, and *storing* information at such a head end, as the Yurt patents require it to do. *See* ‘992:22:45-47, 23:5-8, 25:46-47, and 26:6-9. Nor does Acacia explain how “receiving system” could have a definite meaning when the patents dictate that it must be able to include such things as an “intermediate storage device,” which, by Acacia’s own admission, simply makes no sense. *See* ‘992:22:9-11 and 26:23-26; Acacia Br. at 44:7-9 and 91:16-18 (defining “intermediate storage device”).

As the Federal Circuit reiterated just weeks ago, “[t]o sustain claims so indefinite as not to give the notice required by the [Patent Act] would be in direct contravention of the public interest which Congress therein recognized and sought to protect.” *Wilson*, 2006 U.S. App. LEXIS 7169, at *20 (internal quotation marks and citation omitted). The U.S. Supreme Court has articulated that public interest as follows:

> The public should not be deprived of rights supposed to belong to it, without being clearly told what it is that limits these rights. The genius of the inventor, constantly making improvements in existing patents,—a process which gives to the patent system its greatest value,—should not be restrained by vague and indefinite descriptions of claims in existing patents from the salutary and necessary right of improving on that which has already been invented. It seems to us that nothing can be more just and fair, both to the patentee and to the public, than that the former should understand, and correctly describe, just what he has

invented, and for what he claims a patent.

Merrill v. Yeomans, 94 U.S. 568, 573-74 (1876). Here, the Yurt patentees failed to associate any consistent meaning with the term "receiving system," and instead used that term haphazardly, in confusing and self-contradictory ways. For this reason, they have violated § 112, ¶ 2's requirement to "particularly point[] out and distinctly claim[]" their alleged invention, and the Court should declare the term "receiving system" in the '992 and '275 patents indefinite.

5. "Items containing (or having) information" ('992 patent, claims 19, 41, 47; '275 patent, claims 2, 5)

This phrase is addressed in the brief filed in the Satellite Defendants, which we join as to this issue.

6. "Time requested by the user" ('992 patent, claims 19, 47; '275 patent, claims 2, 5)

Round 1 and 2 Defendants propose that the Court construe the term above to mean a time specified by a user in a request. Because a request must be made to someone or something, and because there is nothing disclosed in the specification or the claims to which such a request could be directed other than the transmission system, Round 1 and 2 Defendants propose that the "time requested by the user" be construed to mean "a time specified by a user in a request to the transmission system."

Acacia's construction fails to give meaning to the term "time requested by the user." Under Acacia's construction, the user never requests a time—but merely requests playback. The Court should reject Acacia' construction because it fails to give the word "request" any real meaning. Pushing "play" is not the same thing as making a request.

The specification describes what it means to request a time for playback, and makes clear that it is a request made by the user for playback to occur at a particular time. For instance, in the specification, the patentees describe one embodiment of the invention as follows:

> If the confirmation performed in step 3070 is correct, the user so indicates and then **inputs a desired delivery time** and delivery location. … Once there is confirmation, **the user enters the playback time** and delivery location. The user then preferably confirms that the order is correct. The confirmation performed in

> step 3100 includes confirmation of the entire transaction including the selected item, **the selected time of playback**, and the location of playback.

992:14:30-45 (emphases added). This feature of selecting a time for playback is described throughout the specification. Figure 3, which is described in the patent as a "flowchart of a preferred method of ordering a selection from a library in accordance with the present invention," '992:3:31-33, shows that "users may enter time and destination," and that after such a request, the "order [is] placed on transmission queue." '992 Fig. 3. *See also* 15:20-23.

7. "User" ('992 patent, claims 19, 47; '275 patent, claims 2, 5)

The Round 1 and 2 Defendants propose that, as used in the Yurt patents, a user is a subscriber or customer. The patentees repeatedly use the term "user" interchangeably in the specification with "subscriber" or "customer," even within a single sentence. For example, the patentees state that "[t]he *user* then enters a *customer* ID code by which the system accesses the user's account, and indicates to the system that the *user is a subscriber of the system*." '992, 14:14-17 (emphases added). They also describe their system as "responsive to a *user* input identifying a choice of an item stored in a source material library to be played back to the *subscriber* at a location remote from the source material library[.]" '992:2:62-66 (emphases added).

Acacia's argument that Round 1 and 2 Defendants are seeking to "add limitations" to the meaning of "user" has no merit. Acacia misleadingly quotes the *Phillips* case as supporting the proposition that the Court should go straight to the dictionary in defining the term "user." Acacia Br. at 23. In fact, the court in *Phillips* rejected that very argument. "The problem is that if the district court starts with the broad dictionary definition in every case and fails to fully appreciate how the specification implicitly limits that definition, the error will systematically cause the construction of the claim to be unduly expansive." *Phillips*, 415 F.3d at 1321. The solution is to focus at the outset on how the patentee used the claim term in the intrinsic evidence "rather than starting with a broad definition and whittling it down." *Id.*

Acacia is asking this Court to do exactly what the *Phillips* court warned against. Acacia proposes the broadest possible construction of the term "user," based solely on a dictionary definition, and ignores the way the term is used in the patents. Under Acacia's proposed construction, a system operator, for example, might qualify as a "user" of the system. But the specification distinguishes between "users" and "operators." *See* '992:14:49-51 ("Access by the users via operator assisted service includes telephone operators who answer calls from the users."); 8:32-45 ("user" can request a particular song, which "[i]nternal to the system," is associated with a number "indexed by the system operator"); 15:16-18 (distinguishing between users and operators); 11:22-32 (same). The Court should reject Acacia's overbroad construction because it is contrary to the intrinsic evidence.

Furthermore, Acacia's construction does nothing to clarify the meaning of the term "user" because it is tautological in nature. Acacia simply states that a "user" is "one that uses." Acacia Br. at 22-23. The Court should reject Acacia's proposed construction because it will not aid the jury in understanding the claims. *See, e.g., Leighton Techs. LLC v. Oberthur Card Sys., S.A.*, 358 F. Supp. 2d 361, 372 (S.D.N.Y. 2005) (rejecting proposed construction because it was "tautological—that is, it contains the very word . . . that it purports to define."); *Rackman v. Microsoft Corp.*, 102 F. Supp. 2d 113, 121 (E.D.N.Y. 2000) ("The Court rejects plaintiff's interpretation because it does not contribute to the task of claim construction. . . . Plaintiff's tautological suggestion is not helpful in resolving the difficult issues presented in this case.").

Accordingly, the Court should construe "user" to mean "a subscriber or customer."

8. "Remote location selected by the user" and "selected remote location" ('992 patent, claims 19, 47)

The parties disagree on the meanings of two terms within the phrases "remote location selected by the user" and "selected remote location," which appear in claims 19 and 47 of the '992 patent and claims 2 and 5 of the '275 patent. First, they disagree on what it means for a user to "select" a remote location. Second, they disagree on whether "location" refers to a premises—as the patentees said that it does—or to some other unit of space.

a. The meaning of "selected"

Acacia, the Round 1 and 2 Defendants, and the Round 3 Defendants have each proposed a different construction of what it means for a remote location to be selected by a user. The

Round 3 Defendants contend that the user must choose a location to send information to that is *different* than the location from which the user makes the request. Thus, under their construction, if a user orders a movie from his home, to satisfy this limitation he *must* request that the movie be sent somewhere other than his home.

Acacia has proffered a definition of "selected" that is no definition at all—Acacia defines "selected" as "selected," which is not helpful. *See Leighton*, 358 F. Supp. 2d at 372 (rejecting tautological construction); *Rackman*, 102 F. Supp. 2d at 121 (same). What Acacia apparently hopes to argue is that a remote location is "selected" by a user even if the user has *no* option other than to send information to the device from which he makes the request. Under Acacia's construction, therefore, this limitation can be satisfied merely by placing an order from a particular location. In other words, according to Acacia, this limitation is satisfied even if a user who orders a movie can only have that movie sent to the device that he used to place the order, and can never specify that it be sent anywhere else.

The Round 1 and 2 Defendants propose a middle ground, which tracks what the patentees emphasized over and over again, in the specification and during prosecution, as being one of the key features of their alleged invention—that the user has the *option* to specify that information be sent to a location other than the location from which he makes the request. Thus, to satisfy this limitation, a user who orders a movie from his home must be able to specify that the movie be sent somewhere other than his home, though he may choose to have it sent to his home as well.

The specification clearly explains that this is what the "selection" process entails:

> In direct connection configurations, such as reception systems 200 shown in FIGS. 1e and 1f, the user preferably **selects** the reception system 200 to which the requested material is sent, and optionally selects the time playback of the requested material as desired. **Accordingly, the user may remotely access the transmission system 100 from a location differenct [sic] than the location of reception system 200 where the material will be sent and/or played back. Thus, for example, a user may preferably call transmission system 100 from work and have a movie sent to their house to be played back after dinner or at any later time of their choosing.**

'992:5:10-21 (emphases added). The specification repeats this explanation numerous times. For example, in describing the ordering process, it states that the user "inputs a desired delivery time *and delivery location* (step 3090)." '992:14:32-33 (emphasis added); *see also* '992:15:22.

Indeed, in the specification's third paragraph, the patentees cited this ability to select a viewing location that is different than the ordering location as a key distinction between their alleged invention and the prior art, particularly the Walter patent:

> While the [Walter] system affords the viewer some control over accessing the material, it requires that a location designated by the viewer be wired with a dedicated cable. **The Walter system further requires the viewer to be at that location for both ordering and viewing the audio/visual material**.

'992:1:23-29 (emphasis added); *see also* '992:1:51-56 (distinguishing the Lang patent on the ground that it does not disclose a system where subscribers can "play back the selected information at a time and place selected by the subscriber").

Even the Abstract provides that the invention is directed to a system in which content is sent to "a receiver specified by a subscriber of the service." Simply placing an order is not the same thing as specifying a receiver to which content will be sent. *See Hill-Rom Co., Inc. v. Kinetic Concepts, Inc.*, 209 F.3d 1337, 1341 n.1 (Fed. Cir. 2000) ("We have frequently looked to the abstract to determine the scope of the invention, [citing cases] and we are aware of no legal principle that would require us to disregard that potentially helpful source of intrinsic evidence as to the meaning of claims."); *Tate Access Floors, Inc. v. Maxcess Techs, Inc.*, 222 F.3d 958, 966 n.2 (Fed. Cir. 2000) ("the abstract of a patent is a potentially useful source of intrinsic evidence as to the meaning of a disputed claim term").

Each of these statements confirms that for a location to be "selected" by the user, the user must in fact make a selection—that is, he must have the option to specify a location that is different than the location from which he is making the request. Indeed, Acacia agrees that the specification states "that the user may make a request from a location different than the location of the reception system . . . ." Acacia Br. at 27:12-13. Yet Acacia still disputes the Round 1 and 2 Defendants' construction, and maintains that this limitation is satisfied by systems that require that viewers be in the *same* location for ordering and viewing information—the exact feature of the Walter system that the patent distinguishes. Because the specification makes clear that a remote location is only "selected" by the user if the user has the option to specify locations that are different than the ordering location, Acacia's construction must be rejected.

If additional support for the Round 1 and 2 Defendants' construction were needed (which it is not), the prosecution history provides it. In remarks filed with the U.S. Patent & Trademark Office on September 30, 1991, the patentees attempted to overcome a rejection by the Examiner to several claims, including the precursor to current claim 19. The Examiner had rejected the claim on obviousness grounds in view of Lang and Fenwick. *See* Silbert Decl. Ex. B (Office Action mailed August 29, 1991) at 3-4. The applicants responded in part by distinguishing Fenwick on the ground that it "does not disclose a system in which a user *can select a remote location* to which a selected item is sent. *Rather in Fenwick et al., a selection can only be sent to the video monitor 102 from which the user issues commands.* " Silbert Decl. Ex. C (September 30, 1991 Remarks) at 23 (emphases added).

Likewise, in connection with the application that led to the '992 patent, the applicants filed a Petition to Make Special in which they distinguished the Monslow patent on the ground that "in Monslow et al., the viewer-chosen program is transmitted to the television receiver of the requesting viewer. The requester *does not have a choice* of where the information that they request is sent." Silbert Decl. Ex. D (Petition to Make Special) at 8 (emphasis added). These statements confirm the understanding, already clear from the specification, that a location is "selected" by a user only if the user has the option to specify that the information be sent to a location other than the ordering location. *See Phillips*, 415 F.3d at 1317 ("[T]he prosecution history can often inform the meaning of the claim language by demonstrating how the inventor understood the invention and whether the inventor limited the invention in the course of prosecution, making the claim scope narrower than it would otherwise be.").

Acacia makes no meaningful argument to the contrary. Instead, it misleadingly groups the Round 1 and 2 Defendants' construction together with that of the Round 3 Defendants, then argues that nothing in the patent *precludes* the user from specifying that information be sent to the same location from which he makes the request. Acacia Br. at 26:11-28:6. With that point, the Round 1 and 2 Defendants do not disagree. But the patent and prosecution history make it absolutely clear that, for a location to be "selected" by a user, the user must have the *option* to specify a location that is different than the ordering location.

b. The meaning of "location"

The Round 1 and 2 Defendants also ask the Court to rule that the "location" that is selected by a user means a "premises" selected by a user. This is what the patentees said they meant by "location." In remarks dated June 7, 1999, filed in connection with the '720 patent in suit, which is part of the Yurt family of patents and shares the same specification, the applicants stated:

> Notably, Applicants have used the term "location" to refer to a premises, rather than merely space in a particular structure. For example, Applicants distinguished U.S. Patent No. 4,506,387, issued to Walter ("the Walter patent") based upon the fact that the system disclosed in the Walter patent requires a dedicated cable wired to the viewer's *premises* and that the viewer be at that *location* for both ordering and viewing the audio/video material.

Silbert Decl. Ex. E (June 7, 1999 Remarks) at 7 (underlining and italics in original).

In its *Markman I* Order, the Court cited this statement, but declined to rule that "location" means "premises" on the ground that "[t]he term location is being applied in [a] different context in that particular situation, and the Court elects not to rely on the prosecution history of a different patent, although the two patents share almost an identical specification, to construe the term location." *Markman I* at 30 n.22. There, the Court was construing the meaning of a transmission system at a first location and a reception system at a second location, and was not addressing what it means for a user to select a location to which content would be sent.

Here, however, the word "location" is being used to describe the place selected by the user to which information will be sent. That is precisely what was at issue in the distinction over Walter. Federal Circuit law holds that the applicant's statements during prosecution are relevant to interpret the disclosures in a patent family's common specification, even when construing terms in prior-issued patents. *Microsoft Corp. v. Multi-Tech Sys., Inc.*, 357 F.3d 1340, 1350 (Fed. Cir. 2004) ("We take the patentee at its word and will not construe the scope of the [prior-issued] '649 patent's claims more broadly than the patentee itself clearly envisioned."). That is particularly appropriate where as here, the distinction over Walter appears in the common specification.

Accordingly, the Round 1 and 2 Defendants ask the Court to hold that the terms "remote location selected by the user" and "selected remote location" in claims 19 and 47 of the '992 patent and claims 2 and 5 of the '275 patent mean "a premises that the user specifies in the request, where one of the available options is a premises that is different from the premises where the user makes the request."

9. "Sending at least a portion of the stored information from the transmission system" ('992 patent, claim 19; '275 patent, claims 2, 5)

This phrase is addressed in the brief filed by counsel for the Round 3 Defendants.

10. The order of the steps of claim 19

The parties all agree that the steps of claim 19 must be performed in the order recited. Acacia also concedes that the "information" referred to in the first storing step must be placed into ordered data blocks, then compressed, and then stored, in that order. Acacia Br. at 31. Accordingly, the parties appear to have no dispute as to the order of claim 19.

11. "Ordering the converted analog signals and the formatted digital signals into a sequence of addressable data blocks" ('992 patent, claim 20)

The argument with respect to the term "sequence of addressable data blocks" is set forth in the brief filed by the Satellite Defendants, which we join as to that issue.

12. The order of the steps of claim 20

All parties agree that the steps of claim 20 must be performed in the order recited. The only dispute is whether, as Acacia asserts, one step may begin before the preceding step is completed. As the Satellite Defendants demonstrate in the section of their brief on the order of claim 41, which we join, Acacia is wrong. Prior steps must be completed before subsequent steps begin.

13. The order of the steps of claim 21

All parties agree that claim 21 refers to the first step of storing of claim 19. All parties also agree that the steps of claim 19 must be performed in order. Round 1 and 2 Defendants ask the Court to construe the language as it is written. Claim 21 states that the first step of storing of claim 19 "includes the substep of storing the items in a plurality of compressed audio and video libraries in the transmission system." As a matter of logic, therefore, the step in claim 21 must be performed as part of the first step of storing of claim 19.

Acacia argues that the step of claim 21 can be performed either "before, after or simultaneously with" the first step of storing. Acacia Br. at 38. But Acacia's construction disregards the claim language, which specifically recites that the first step of storing of claim 19 "includes" the step of claim 21. Therefore, Acacia's construction should be rejected.

The cases cited by Acacia are not to the contrary—those cases generally concern when the steps of a method claim must be performed in a particular order. Indeed, Acacia acknowledges that these cases set forth the test to apply "if the steps of or method claim . . . do not otherwise recite an order." Acacia Br. at 38. But here, the claim language itself dictates that the step of storing information from items of compressed data form must include storing the items in a plurality of compressed audio and video libraries. Thus the claims themselves require that these events happen as part of a single event. Because Acacia agrees that the steps of claim 19 must be performed in order, it follows that the step of claim 21 must be performed before the sending of a request, and at the same time as the first step of storing.

14. "The step of storing includes the step of storing the received information at the head end of a cable television reception system" ('992 patent, claim 23)

Acacia argues that claim 23 refers to storing information at a cable head end *before* it is sent to the receiving system: "the information is stored *first* at the head end, and *second* at the receiving system." Acacia Br. at 42. But that is not what claim 23 says.

Acacia agrees that claim 23 refers to the second step of storing in claim 19. Acacia also agrees that the steps in claim 19 must be performed in order. Thus the second step of storing in claim 19 must take place after the immediately preceding step: "receiving the sent information *by the receiving system at the selected remote location*." '992 Claim 19 (emphasis added). As a result, the received information must be stored at the cable head end after it is received by the receiving system at the selected remote location. This may make little sense, but the Court cannot rewrite the plain meaning of the claim. *See Chef Am.*, 358 F.3d at 1374.

15. The order of the steps of claim 23

All parties agree that the step of storing referred to in claim 23 is the second step of storing of claim 19. Acacia also concedes that the step of claim 23 is "part of the second step of storing of claim 19." Acacia Br. at 43. Yet Acacia immediately reverses itself by stating that the step of claim 23 is "performed before the second step of storing." *Id.* For the reasons set forth above, the Court should reject Acacia's construction, which not only contradicts the claim language, but contradicts itself.

16. "The step of storing includes the step of storing the received information in an intermediate storage device" ('992 patent, claim 20)

Acacia concedes that an intermediate storage device is a storage device that is between the transmission system and the receiving system. Acacia Br. at 44. Acacia also agrees that claim 20 refers to the second step of storing in claim 19. The second step of storing takes place after information has been received by the receiving system at the selected remote location. As a result, the claim requires that, after information is received by the receiving system, it is stored in an intermediate storage device that is between the transmission system and the receiving system. As with claim 23, this makes little sense, but it is what the claim requires.

17. The order of the steps of claim 24

As with claim 23, the Court should reject Acacia's self-contradictory construction that the step of claim 24 is both "part of the second step of storing," *and* "performed before the second step of storing." Acacia Br. at 46. Acacia cannot rewrite the claims to make sense out of them—much less to make them even more nonsensical.

18. "A method of transmitting information to remote locations, the transmission method comprising the steps, performed by a transmission system, of" and "comprises the steps, performed by a transmission system" ('992 patent, claims 20, 41)

19. "Sequence of addressable data blocks" ('992 patent, claims 20, 41)

The argument with respect to these terms is set forth in the brief filed by the Satellite Defendants, which we join as to these issues.

20. "Compressing the formatted and sequenced data blocks" ('992 patent, claim 41)

The Round 1 and 2 Defendants agree with Acacia that this phrase does not require further construction.

21. "Sending at least a portion of the file to one of the remote locations" ('992 patent, claim 41)

The argument with respect to this phrase is set forth in the brief filed by the Satellite Defendants, which we join as to this issue.

22. The order of the steps of claim 41

The argument with respect to the order of the steps of claim 41 is set forth in the brief filed by the Satellite Defendants, which we join as to this issue.

23. The order of the steps of claim 42

24. The order of the steps of claim 43

25. The order of the steps of claim 44

All parties agree that the steps of these claims must be performed in the order recited. The only dispute is whether, as Acacia asserts, the steps of these claims can be performed "before, after or simultaneously with" the steps of claim 41 in which they are "include[ed]." Acacia Br. at 58-62. As demonstrated above with respect to claims 21, Acacia is wrong. The steps of these claims must be performed as part of the steps in which they are included. *See* No. 13, *supra*.

26. "Separately storing a plurality of files, each including compressed, sequenced data blocks" ('992 patent, claim 45)

Claim 45 is indefinite, as demonstrated in the brief filed by the Satellite Defendants, which we join as to this issue.

27. The order of the steps of claim 45

As with claims 21, 42, 43, and 44, the step of claim 45 must be performed as part of the "storing as a file" step to which it refers. *See* Nos. 13, 23-25, *supra*.

28. "Receiving transmission requests to transmit available items" ('992 patent, claim 46)

Claim 46 is indefinite because it depends from Claim 45, which is also indefinite by virtue of failing to specify which file is transmitted, as set forth in the brief filed by the Satellite companies.

29. The order of the steps of claim 46

The parties all agree that the steps of claim 46 must be performed in the order in which they are recited. But Acacia claims that the steps of claim 46 may also be performed "before, after, or simultaneously with any other step of claim 41." Acacia Br. at 67. Acacia is wrong. Claim 46 recites "retrieving *stored formatted data blocks* corresponding to requests from users." '992 Claim 46 (emphasis added). Thus, the steps of claim 46 must be performed after the step of "storing, as a file, the compressed, formatted, and sequenced data blocks. . . ." '992 Claim 41.

30. "Storage means in the transmission system for storing information from the items in a compressed data form, in which the information includes an identification code and is placed into ordered data blocks" ('992 patent, claim 47)

a. This element is governed by section 112, paragraph 6.

As the Court is well aware, a claim element that uses the word "means" in association with a function is presumed to be governed by 35 U.S.C. § 112, ¶ 6. *Markman I* at 8-9; *Callicrate v. Wadsworth Mfg.*, 427 F.3d 1361, 1368 (Fed. Cir. 2005). Acacia concedes that this presumption applies to the "storage means" element of claim 47, but argues that the term "storage" connotes sufficient structure to rebut the presumption. Acacia Br. at 69. Contrary to that assertion, the Federal Circuit and district courts have construed "storage means" and related phrases as governed by § 112, ¶ 6. *See, e.g., State St. Bank & Trust Co. v. Signature Fin. Group*, 149 F.3d 1368, 1371 (Fed. Cir. 1998) ("storage means" governed by § 112, ¶ 6); *Globetrotter Software v. Elan Computer Group*, 1999 U.S. Dist. LEXIS 22482, *29-30 (N.D. Cal. 1999) (same for "program storage means"); *General Creation LLC v. Leapfrog Enters.*, 232 F. Supp. 2d 661, 678 (W.D. Va. 2002) (same for "memory storage means").

Moreover, in *Markman I*, this Court held that the closely-related phrase "compressed data storing means, coupled to the data compression means, for storing as files the compressed, sequenced data blocks received from the data compression means with the unique identification code assigned by the identification encoding means" is governed by § 112, ¶ 6. *Markman I* at 23. Indeed, Acacia explicitly conceded the point in its initial claim-construction brief. *See* Acacia's January 8, 2003 Br. at 34. Acacia cannot now argue that *removing* the word "compressed" from "compressed storage means" somehow *adds* sufficient structure to rebut the presumption that § 112, ¶ 6 applies.

b. This element, like the equivalent element in claim 1, corresponds to both compressed data formatter 117 and compressed data library 118.

Because § 112, ¶ 6 applies, the next step is determining what structures, if any, the specification discloses for performing the function "storing information from the items in a compressed data form, in which the information includes an identification code and is placed into ordered data blocks." '992 Claim 47; *Kemco Sales, Inc. v. Control Papers Co.*, 208 F.3d 1352, 1361 (Fed. Cir. 2000). The "structure disclosed in the specification must be clearly linked to and capable of performing the function claimed by the means-plus-function limitation." *Default Proof Credit Card Sys. v. Home Depot U.S.A., Inc.*, 412 F.3d 1291, 1299 (Fed. Cir. 2005).

The Court has already construed the equivalent function in claim 1: "storing as files the compressed sequenced data blocks received from the data compression means with the unique identification code assigned by the identification encoding means." *Markman I* at 23. As the Court held, "[t]he corresponding structure for creating and storing a file is the compressed data formatter 117. . . . The corresponding structure for storage of the file is the compressed data library 118." *Id.*

Furthermore, the specification clearly links the function in claim 47 of "storing information from the items in a compressed data form, in which the information includes an identification code and is placed into ordered data blocks" to *both* compressed data formatter 117 and compressed data library 118. Indeed, the specification repeatedly identifies the compressed data formatter 117 as the "compressed data storage means":

> [T]he transmission system 100 may further comprise compressed data storing means, coupled to the compression means, for storing as a file the compressed sequenced data with the unique identification code received from the data compression means. After compression processing by compressor 116, the compressed audio and video data is preferably formatted and placed into a single file by the *compressed data storage means 117*. . . . The file is addressable through the unique identification code assigned to the data by the identification encoder 112. . . . The compressed data storage means preferably includes compressed data library 118, as shown in FIG. 2b. After the data is processed into a file by the *compressed data storage means 117*, it is preferably stored in a compressed data library 118.

’992:10:18-39 (emphases added).

The Court should construe the “storage means” element of claim 47 in a manner that is consistent with the specification and the Court’s prior construction of the equivalent “means” in claim 1. Thus, the Court should hold that the “storage means” element of claim 47 corresponds to both the compressed data formatter 117 and the compressed data library 118.

c. The claim is indefinite because the specification does not disclose sufficient structure for compressed data formatter 117.

In *Markman I*, this Court raised, but declined to answer, the question “whether the specification of the ‘992 patent discloses sufficient structure for any term, in particular, the ‘compressed data formatter.’” *Markman I* at 23 n.18. The time is now ripe for the Court to answer that question in the negative and hold that claim 47 is invalid for indefiniteness.

Section 112, paragraph 6 “represents a quid pro quo by permitting inventors to use a generic means expression for a claim limitation provided that the specification indicates what structure(s) constitute(s) the means.” *Markman I* at 23 n.18 (quoting *Atmel Corp. v. Information Storage Devices*, 198 F.3d 1374, 1382 (Fed. Cir. 1999)). “If a patentee fails to satisfy the bargain because of a failure to disclose adequate structure, the claim will be rendered invalid as indefinite under Section 112, paragraph 2.” *Kemco Sales, Inc*, 208 F.3d at 1360-1361 (Fed. Cir. 2000); *see also Budde v. Harley-Davidson, Inc.*, 250 F.3d 1369, 1376 (Fed. Cir. 2001); *In re Donaldson Co.*, 16 F.3d 1189, 1195 (Fed. Cir. 1994) (en banc).

The “compressed data formatter 117” is never described in terms of its structure, its component parts, or whether it is hardware or software. It appears as element 117 in Figure 2a, but as this Court previously recognized, a block in a diagram that amounts to nothing more than a "black box" cannot satisfy the means-plus-function tradeoff. *See Markman I* at 19:6-9. "[B]ecause the Court is construing a means-plus-function claim, the Court must examine the specification to determine the substance of the identified structure and to determine if the identified structure performs the required functions." *Id.*

The specification does not contain any information that would allow a person of ordinary skill in the art to determine the substance of the identified structure. Rather, the few passages referring to compressed data formatter 117 speak only of its function. The specification states that "the compressed audio and video data is preferably formatted and placed into a single file by the compressed data storage means 117." '992 7:23-26; *see also* 7:44-58 (compressed data formatter 117 reformats data to make it compatible with material stored in the compressed data library); 8:2-6 (time encoding allows for realignment of audio and video information in the compressed data formatter 117); 12:65-68 (program notes can be contained in the compressed file formed in the compressed data formatter 117).

Thus, the Court should hold that claim 47 is indefinite and invalid because the specification fails to disclose adequate structure for the "storage means."

31. "Requesting means in the transmission system, coupled to the storage means, for receiving requests from a user for at least a part of the stored information to be transmitted to the receiving system at one of the remote locations selected by the user" ('992 patent, claim 47)

This element is indefinite because it incorporates the indefinite terms "receiving system" and "storage means." It is also indefinite because the specification does not disclose sufficient structure for the "requesting means."

All parties agree that this function is to be construed pursuant to § 112, ¶ 6. The function recited is "receiving requests from a user for at least a part of the stored information to be transmitted to the receiving system at one of the remote locations selected by the user." Acacia argues that the corresponding structure is "library access interface 121." Acacia Br. at 73-74. But again, 121 is simply a box in a diagram, and the specification does not disclose the structure of "library access interface 121." Furthermore, as shown in Figure 2b, on which Acacia relies, "library access interface 121" is not "coupled to"—*i.e.*, "directly attached to"—the storage means, as the claim requires. *See* '992 Fig. 2b; *Markman I* at 22-23. And while the claim requires that the "requesting means" be "in the transmission system," the patentees themselves could not decide whether the "library access interface 121" was in the transmission system or, as they also state, "in the reception system." '992:17:44-45; *cf.* Fig. 2b; 3:28-29 (showing interface 121 as part of the "transmission system of the present invention"). Thus, the specification does not clearly link the claimed function to "library access interface 121," or disclose sufficient structure to satisfy the means-plus-function *quid pro quo*. Claim 47, therefore, is indefinite.

Alternatively, if the Court does not find claim 47 indefinite, it should hold that the "requesting means" is limited to Figure 3 and its equivalents. Figure 3 shows an algorithm for processing user requests, and is the closest thing in the specification to a disclosure of structure that is sufficient to satisfy the requirement that it be clearly linked to the claimed function, and sufficiently detailed to allow one of ordinary skill in the art to implement it. *See Med. Instrumentation & Diagnostics Corp. v. Elekta AB*, 344 F.3d 1205, 1212 (Fed. Cir. 2003) ("The correct inquiry is to look at the disclosure of the patent and determine if one of skill in the art would have understood that disclosure to encompass software . . . and been able to implement such a program, not simply whether one of skill in the art would have been able to write such a software program.").

32. "Transmission means in the transmission system, coupled to the requesting means, for sending at least a portion of the stored information to the receiving system at the selected remote location" ('992 patent, claim 47)

This element is indefinite because it incorporates the indefinite terms "receiving system" and "requesting means." Moreover, while Acacia cites element 200d in Figure 1g as corresponding structure, the figure and the specification make clear that 200d is in the reception system, not "in the transmission system," as the claim requires. *See* '992 Fig. 1g; 4:52-57 ("FIG. 1g shows . . . a reception system 200, which then preferably transmits requested material over airwave communication channels 200d, to a plurality of users."). Contrary to Acacia's assertion, therefore, 200d cannot be corresponding structure for the claimed function.

33. "Receiving means in the receiving system for receiving the transmitted information" ('992 patent, claim 47)

This phrase is indefinite because it includes the indefinite term "receiving system."

34. "Memory means in the receiving system, coupled to the receiving means, for storing a complete copy [of] the received information" ('992 patent, claim 47)

This phrase is indefinite because it uses the indefinite term "receiving system." If, however, the Court construes the phrase, it should do so under § 112, ¶ 6. Contrary to Acacia's assertions, the word "memory" is not sufficient structure to overcome the presumption that § 112, ¶ 6 applies. *See, e.g., Genlyte Thomas Group LLC v. Lutron Elecs. Co.*, 2004 U.S. Dist. LEXIS 5311, at *31 (N.D. Tex. 2004) (where "the only possible structure" recited in the claim was the term "memory," the means-plus-function presumption was not overcome).

Although Acacia cites to element 200c of Figure 1f as a structure corresponding to the function of "storing a complete copy of the received information," that element does not show a memory device that is "in the receiving system," as the claim requires. Rather, 200c is described as an "intermediate storage device," which by Acacia's own definition is "*between the transmission system and the receiving system*." Acacia Br. at 44 (emphasis added); *see also* '992 4:42; 5:23-24.

Acacia also cites to storage 203 in Figure 6, but that "structure"—if a cylinder in a figure that is described in no more detail than as "storage" can be called a structure—is not "coupled to" the element that Acacia identifies as the "receiving means" (transceiver 201), as the claim requires. *See Markman I* at 22-23 (construing "coupled to" to mean "directly attached to").

35. "Playback means in the receiving system, coupled to the memory means, for playing back the stored copy of the received information at a time requested by the user" ('992 patent, claim 47)

This phrase is indefinite because it includes the indefinite terms "receiving system" and "memory means." It is also indefinite because the specification does not link the claimed function to sufficient structure, and because the term "playback" is itself indefinite. It is worth noting that Acacia itself has not been able to decide which structure in the specification corresponds to the playback function. Acacia first claimed that the corresponding structure was a television set or audio amplifier. Silbert Decl. Ex. A (Acacia's proposed constructions sent March 17, 2006) at 10. *See also* 992:18:36-37 ("The real time output signals are output to a playback device such as a TV or audio amplifier."). But Acacia was forced to retract that construction because neither a television set nor an audio amplifier is "in the receiving system," as required by the claim. *See* '992 Fig. 6; 17:25-26; 18:36-37.

Now Acacia claims that the corresponding structures to the playback means are a data formatter 204, video/audio decompressor 208/209, and converter 206. Acacia Br. at 79. Even if one could ignore the statements in the specification that the playback device is a television or audio amplifier, the specification does not disclose sufficient structure for this element. The specification states that the function of "playing back the decompressed information in real time at a time specified by the user" is performed by the "output data conversion means." '992:3:11-14. This "means," in turn, appears to correspond to converter 206, which is called "output format conversion" in Figure 6. Nothing suggests that the data formatter 204 or video/audio compressor 208/209 have anything to do with playback. There is only one reference to converter 206 aside from the figure, which states that "decompressed video data is then sent simultaneously to converter 206 including digital video output converter 211 and analog video output converter 213. The decompressed audio data is sent simultaneously to digital audio output converter 212 and analog audio output converter 214. The outputs from converters 211-214 are produced in real time." '992:18:29-35. This statement does not specify the structure of converter 206. Indeed, one is left to guess not only at its structure, but also at the kind of conversion it is supposed to perform, and what that has to do with the function of playing back the stored copy at a time requested by the user. Thus, the claim is indefinite.

36. "Conversion means, for converting the analog signals of the information to digital components" ('992 patent, claim 48)

37. "Formatting means, coupled to the conversion means, for formatting the digital signals of the information" ('992 patent, claim 48)

38. "Ordering means, coupled to the formatting means, for ordering the converted analog signals and the formatted digital signals into a sequence of addressable data blocks" ('992 patent, claim 48)

39. "Compression means, coupled to the ordering means, for compressing the ordered information" ('992 patent, claim 48)

Claim 48, which depends on claim 47, states that the "storage means further comprises" each of the elements listed above. But as demonstrated above, the term "storage means" is indefinite. Thus, claim 48 is also indefinite.

Even if the Court finds that the "storage means" element of claim 47 is not indefinite, there is no recited structure in the specification that is part of the storage means and performs the functions set out in claim 48. Acacia claims that the corresponding structure for "storage means" is "compressed data library 118" in Figure 2b. Acacia Br. at 69. Acacia also claims that the corresponding structures for the conversion, formatting, ordering, and compression means are converter 123a/123b; formatter 125a/125b; time encoder 114; and compressor 116. *Id.* at 81-86. But claim 48 requires that the storage means further comprise the conversion means, formatting means, ordering means and compression means. In other words, the conversion means, formatting means, ordering means and compression means must be contained within the storage means, which Acacia defines as the compressed data library. It is clear from Figures 2a and 2b, and the rest of the specification, that none of the structures that Acacia links to the functions in claim 48 are part of the compressed data library. In fact, the compressed data library does not even appear in the figure that depicts the structures that purportedly correspond to the conversion, formatting, ordering, and compression means. *See* Fig. 2a. Further, there are no other structures disclosed in the specification that are part of an alleged "storage means" and also perform the conversion, formatting, ordering, and compression functions. Thus, claim 48 is invalid for indefiniteness.

40. "A distribution system as recited in claim 47, wherein the memory means includes a means for receiving information at the head end of a cable television reception system" ('992 patent, claim 49)

41. "A distribution system as recited in claim 49, wherein the head end of the cable television reception system includes means for distributing compressed signals" ('992 patent, claim 51)

42. "A distribution system as recited in claim 49, wherein the head end of the cable television reception system includes means for decompressing the received signals and for distributing the decompressed received signals and compressed received signals" ('992 patent, claim 52)

Claims 49, 51, and 52 are all indefinite for similar reasons. They all incorporate the indefinite term "memory means." Moreover, claims 49, 51 and 52 are also indefinite for inadequate disclosure of structure in the specification. The claims specify that the "memory means" includes a "means for receiving information at the head end of a cable television reception system." Yet there is no corresponding structure for "receiving information at the head end," much less a corresponding structure that is part of the "memory means." The written description contains a single paragraph referring to a cable head end, and it says nothing about a structure for receiving information. *See* '992:4:44-51.

Acacia argues that the structure disclosed for the memory means is the cylindrical element labeled 203 in Figure 6, or 200c in Figure 1f. Acacia Br. at 79. Acacia then argues that the structure for "receiving information at the head end of a cable television reception system" is transceiver 201 in Figure 6. Transceiver 201, however, is not part of either 203 in Figure 6 or 200c in Figure 1f. It is a separate component in Figure 6, and not included in any form in Figure 1f. Moreover, transceiver 201 in Figure 6 is not located at a cable head end. Figure 6 shows transceiver 201 as part of a device that includes the "user/computer interface," which is also referred to as the "viewer control interface." There is no indication that this device is located at a cable head end, and every indication that it is not, as it would make no sense to locate the user/viewer control interface at the head end. Rather, Figure 6 appears to show a device that is located at a user's premises—*i.e.*, a "set top box." Thus, claims 49, 51, and 52 are indefinite.

Claims 51 and 52 are also indefinite because the specification does not disclose any structure at a cable head end that performs the functions of "distributing compressed signals" (claim 51) or "decompressing the received signals and . . . distributing the decompressed received signals and compressed received signals" (claim 52). *See* '992:4:44-51; Claims 51-52. Acacia concedes as much, but claims that "the patent implicitly discloses a cable television transmitter at the head end . . . and that such transmitters were disclosed in the '992 patent in Figure 2b." Acacia Br. at 88, 90. But Figure 2b depicts "the *transmission system*," not the "head end of a cable television *reception system*" that somehow includes or is included in a "memory means in the *receiving system*," whatever that means. '992:3:28-30; 5:59-61; Claims 47, 51-52 (emphases added). Acacia cannot hope to save its indefinite and contradictory claims by ignoring its own patent and relying exclusively on what it alleges is known by those skilled in the art. *See Med. Instrumentation*, 344 F.3d at 1212 ("It is not proper to look to the knowledge of one skilled in the art apart from and unconnected to the disclosure of the patent.").

43. "A distribution system as recited in claim 47, wherein the memory means is an intermediate storage device" ('992 patent, claim 53)

This phrase is indefinite because it includes the indefinite term "memory means." But the Round 1 and 2 Defendants agree with Acacia that "intermediate storage device" means "a storage device that is between the transmission system and the receiving system." Acacia Br. at 91.

44. "Reception system associated with a receiving system at one of the remote locations selected by the user" ('275 patent, claims 2, 5)

45. "Sending a request, by the user to the transmission system, for at least a part of the stored information to be transmitted to a reception system associated with a receiving system" ('275 patent, claims 2, 5)

46. "Playing back the stored copy of the information from the reception system to the receiving system at the selected remote location at a time requested by the user" ('275 patent, claim 2)

47. "Sending at least a portion of the stored information from the transmission system to the reception system" ('275 patent, claim 2)

48. "Playing back the stored copy of the information sent over a cable communication path from the reception system to the receiving system at the selected remote location at a time requested by the user" ('275 patent, claim 5)

These claims are indefinite for the reasons set forth above with respect to "receiving system." It is unclear what it would mean for a "reception system" to be "associated with" a "receiving system," or what the functionality or structure of these systems would be.

49. The order of the steps of claims 2 and 5

As with claim 19, the parties appear to have no dispute with respect to the order of claims 2 and 5 of the '275 patent. *See* No. 10, *supra*.

III. CONCLUSION

For all of the foregoing reasons, this Court should adopt the constructions proposed by the Round 1 and 2 Defendants and hold that '992 claims 19-40 and 47-58, and '275 claims 2 and 5, are invalid for indefiniteness.

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